

**REMARKS**

Claims 1 and 4 are amended by deleting the phrase "the toner contains a release agent . . . by weight of the binder resin."

Claims 3 and 7 are amended to recite "an image forming apparatus" and that the developing unit contains a toner as suggested by the Examiner.

Claims 3 and 7 are further amended to recite that the toner "has a dynamic viscoelastic characteristic showing a behavior of a linear region (L1) at an inlet of a fixing nip, a behavior of a nonlinear region (NL) at the fixing nip part, and a behavior of a linear region (L2) at an outlet of the fixing nip." Support for the amendment can be found, for example, at page 9, lines 6-11 of the specification.

No new matter is presented.

**I. Response to Claim Rejections under 35 U.S.C. § 112**

Claims 3 and 7 are rejected under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph, as allegedly being indefinite. The Examiner states that the phrase "an image forming system" is not clear.

Claims 3 and 7 are rejected under 35 U.S.C. § 112, 1st paragraph, as allegedly failing to comply with the written description requirement. The Examiner states that the originally filed specification does not reasonably provide an adequate written description for the phrase "an image forming system comprising an image forming apparatus and a toner".

Claims 3 and 7 are amended to recite, "An image forming apparatus comprising . . . a developing unit containing a toner, wherein the developing unit develops the electrostatic latent image on the image carrier to form a toner image by the toner. . . according to claim 1" as suggested by the Examiner in the first paragraph at page 8 of the Office Action.

Accordingly, the section 112 rejections are obviated and Applicants respectfully request withdrawal thereof.

## **II. Response to Art Rejections**

### **A. Matsumura as evidenced by Applicants' Alleged Admissions**

Claims 1, 4 and 5 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by WO 02/084408 A1 (Matsumura) as evidenced by Applicants' alleged admissions as set forth in paragraph 10 at page 8 of the Action (Applicants' Admission I).

Applicants respectfully traverse the rejection.

The Examiner recognizes that Matsumura does not disclose the storage modulus properties recited in the present claims. However, the Examiner takes the position that it is reasonable to presume that Matsumura's toner has the claimed storage modulus because the Matsumura toner meets the compositional requirements of the present claims and in view of the temperature characteristics of Matsumura's toner (page 10, the bottom paragraph to page 13).

Applicants respectfully submit that the Examiner has not met her burden to provide a reasonable technical basis for asserting that the toner taught by Matsumura has the storage modulus properties recited in the present claims. From a technical point of view, the disclosure of Matsumura is insufficient to determine the storage modulus of the toner. Matsumura does not disclose or suggest the claimed toner having specific viscoelastic characteristics, i.e., the relationship between storage modulus of a linear region and a nonlinear region. An important feature of the present invention is to provide a toner having the claimed features, thereby a linear region and a nonlinear region of dynamic viscoelastic characteristics of the toner are

effectively utilized in fixation by heating, and the melting of the toner in the fixing nip is performed smoothly. Thus, it becomes possible to effectively improve low temperature fixing ability and offset resistance of the toner. Matsumura does not disclose, teach or recognize these features of the present invention and their advantageous effects.

Further, Applicants note that it is improper for the Examiner to rely on the description in the specification of Applicants' invention. Every portion of the specification to which the Examiner refers as "Applicants' Admissions" is related to a description of the present invention and is not a discussion of the prior art. It is improper to rely on the description of the invention as prior art against the claims. Thus, the Examiner's alternative conclusion of obviousness appears to be based upon improper hindsight reasoning since the claimed invention as a whole is not taught or suggested by the cited references and is only reconstructed based upon Applicants' teachings in the specification. The suggestion or motivation to modify or combine references must be found in the prior art and not based upon Applicants' disclosure.

In view of the above, Applicants submit that Matsumura does not disclose, teach or suggest all elements of the present invention and therefore does not anticipate, nor render obvious the present invention. Accordingly, Applicants respectfully request withdrawal of the rejection.

**B. Izawa, Matsumura as evidenced by Applicants' Alleged Admissions**

Claims 3 and 7 are rejected under 35 U.S.C. § 103 as allegedly being obvious over U.S.

Pat. No. 6,748,192 B2 (Izawa) combined with Matsumura as evidenced by Applicants'

Admission I.

Applicants respectfully traverse the rejection.

None of the cited references discloses or suggests the claimed toner having specific viscoelastic characteristics, i.e., the relationship between storage modulus of a linear region and a nonlinear region. As stated above, an aspect of the claimed invention is to provide a toner having the claimed features, thereby a linear region and a nonlinear region of dynamic viscoelastic characteristics of the toner are effectively utilized in fixation by heating, and the melting of the toner in the fixing nip is performed smoothly, and it becomes possible to effectively improve low temperature fixing ability and offset resistance of the toner. Neither Izawa nor Matsumura discloses, teaches or recognizes these features of the present invention and their advantageous effects. Thus, one of ordinary skill in the art would not have been motivated to combine the references as suggested by the Examiner.

Also, it is improper for the Examiner to rely on the description in the specification of Applicants' invention. Every portion of the specification to which the Examiner refers as "Applicants' Admissions" is related to a description of the present invention and is not a discussion of the prior art. It is improper to rely on the description of the invention as prior art against the claims. Thus, the Examiner's conclusion of obviousness appears to be based upon improper hindsight reasoning since the claimed invention as a whole is not taught or suggested by the cited references and is only reconstructed based upon Applicants' teachings in the

specification. The suggestion or motivation to modify or combine references must be found in the prior art and not based upon Applicants' disclosure.

In view of the above, Applicants submit that the cited references do not disclose, teach or suggest all elements of the present invention and therefore do not render obvious the present invention. Accordingly, Applicants respectfully request withdrawal of the rejection.

**C. Yamazaki**

Claims 3 and 7 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Pub. No. 2005/0100807 A1 (Yamazaki) as evidenced by Applicants' Admission I.

Claims 3 and 7 are amended to recite, "An image forming apparatus comprising...a developing unit containing a toner, wherein the developing unit develops the electrostatic latent image on the image carrier to form a toner image by the toner. . . and the toner is the toner according to claim 1." Further, Applicants have previously submitted a sworn English translation of Japanese Patent Application Nos. 2003-053833 and 2003-053834, thereby perfecting the claim to priority under 35 U.S.C. § 119(a) and antedating Yamazaki. Thus, Yamazaki is removed as prior art.

Accordingly, Applicants respectfully request withdrawal of the rejection.

**III. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111  
Appln. No. 10/787,099

Atty. Docket No. Q80152

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

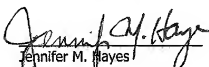
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Date: November 6, 2006